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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,938	12/03/2003	Leo Ernest Manzer	CL2055US DIV	6997

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EXAMINER
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SHIAO, REI TSANG

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 10/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/727,938

Applicant(s)

MANZER, LEO ERNEST

Examiner

Robert Shiao

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on application filed on 12/03/2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-17 and 19-22 is/are pending in the application.
- 4a) Of the above claim(s) 3, 6, 14, 15 and 19-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2, 4-5, 7-13, and 16-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |                                                                                                                                                 |                                                                                                    |
|-------------------------------------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                     | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                                             | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                        |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/03/2003</u> . | 6) <input type="checkbox"/> Other: _____                                                           |

### **DETAILED ACTION**

1. Applicant's preliminary amendment including cancellation of claims 1 and 18 in Paper No. 1203, dated December 03, 2003, is acknowledged. Claims 2-17, 19-22 are pending in the application.

### ***Election/Restriction***

2. The group set forth in the claims includes both independent and distinct inventions, and patentably distinct compounds (or species) within each invention. However, this application discloses and claims a plurality of patentably distinct inventions far too numerous to list individually. Moreover, each of these inventions contains a plurality of patentably distinct compounds, also far too numerous to list individually. For these reasons provided below, restriction to one of the following Groups is required under 35 U.S.C. 121, wherein an Group is a set of patentably distinct inventions of a broad statutory category (e.g. Compounds, Methods of Use, Methods of Making, etc.):

- I. Claims 2, 4-5, 7-13, 16-17, in part, drawn to a process of making compounds of formula VII and VIII, classified in class 548, with various subclasses. If this group is elected, applicants are requested to elect a single species for the search purpose.

- II. Claims 3-13, 14-17, in part, drawn to a process of making compounds of formula XI and XII, classified in class 548, with various subclasses. If this group is elected, applicants are requested to elect a single species for the search purpose.
- III. Claim 19, drawn to a process of making agrochemical compositions, classified in class 504, with various subclasses. If this group is elected, applicants are requested to elect a single species for the search purpose.
- IV. Claim 20, drawn to a process of making cleaning compositions, classified in class 510, with various subclasses. If this group is elected, applicants are requested to elect a single species for the search purpose.
- V. Claim 21, drawn to a process of making ink jet ink compositions, classified in class 523, with various subclasses. If this group is elected, applicants are requested to elect a single species for the search purpose.
- VI. Claim 22, drawn to a process of making refrigerant compositions, classified in class 62, with various subclasses. If this group is elected, applicants are requested to elect a single species for the search purpose.

An election of any one of Groups I-VI is required. Should applicant traverse on the ground that the compounds are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the compounds to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C 103(a) of the other.

Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventors must be amended in compliance with 37C.F.R. 1.48(b) if one of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 C.F.R. 1.48(b) and by the fee required under 37CFR 1.17(i).

If desired upon election of a single compound, applicants can review the claims and disclosure to determine the scope of the invention and can **set forth** a group of compounds which are so similar within the same inventive concept and reduction to practice. Markush claims must be provided with support in the disclosure for each member of the Markush group. See MPEP 608.01(p). Applicant should exercise caution in making a selection of a single member for each substituent group on the base molecule to be consistent with the written description.

***Rationale Establishing Patentable Distinctiveness Within Each Group***

Each Invention Set listed above is directed to or involves the use or making of compounds which are recognized in the art as being distinct from one another because of their diverse chemical structure, their different chemical properties, modes of action,

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different effects and reactive conditions (MPEP 806.04, MPEP 808.01). Additionally, the level of skill in the art is not such that one invention would be obvious over either of the other inventions, i.e. they are patentable over each other. Chemical structures which are similar are presumed to function similarly, whereas chemical structures that are not similar are not presumed to function similarly. The presumption even for similar chemical structures though is not irrebuttable, but may be overcome by scientific reasoning or evidence showing that the structure of the prior art would not have been expected to function as the structure of the claimed invention. Note that in accordance with the holdings of Application of Papesch, 50 CCPA 1084, 315 F.2d 381, 137 USPQ 43 (CCPA 1963) and In re Lulu, 223 USPQ 1257 (Fed. Cir. 1984), chemical structures are patentably distinct where the structures are either not structurally similar, or the prior art fails to suggest a function of a claimed compound would have been expected from a similar structure.

***The above Groups represent general areas wherein the inventions are independent and distinct, each from the other because of the following reasons:***

Groups I-VI are independent and distinct processes, because starting materials, reaction conditions or processes, each group differ in elements, bonding arrangement and chemical property to such an extent that a reference anticipating compounds of any one group would not render another group obvious.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the

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case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

In addition, because of the plethora of classes and subclasses in each of the Groups, a serious burden is imposed on the examiner to perform a complete search of the defined areas. Therefore, because of the reasons given above, the restriction set forth is proper and not to restrict would impose a serious burden in the examination of this application.

### ***Responses to Election/Restriction***

3. During a telephone conversation with Gerald Deitch on September 1, 2004, a provisional election was made without traverse to prosecute the invention of Group I, claims 2, 4-5, 7-13, and 16-17, in part. Affirmation of this election must be made by applicant in replying to this Office action. Claims 3, 6, 14-15, and 19-22 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 2, 4-5, 7-13, and 16-17 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2, line 1, recites the limitation "comprising", is ambiguous and indefinite. The instant process is a process of making products comprising compounds of formula (VII) and formula (VIII) or their mixture. The instant claims recites the limitation "comprising", which is an open-end language and comprise products other than the compound of formula (VII) and (VIII) and their mixture, i.e., 5-methyl-2,3-dihydro-1H-1-benzazepin-2-one, see page 2023, lines 13-19 of Candeloro et al. publication, Aust. J. Chem., 1978, 31:2031-7. Replacement of the limitation "comprising" with the limitation "consisting of", would obviate the rejection, see pages 2-3.

### ***Objection***

5. Claims 4, 7, 9-11, and 16-17 are objected to under 37 CFR 1.75(c), as being of improper dependent form, i.e., they dependent on claim 3, for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claims, or amend the claims to place the claims in proper dependent form, or rewrite the claims in independent form. It is noted that claim 3 belongs to a non-elected invention.

### ***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Shiao whose telephone number is (571) 272-0707. The examiner can normally be reached on 8:30 AM - 5:00 PM.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

R.S.-

Robert Shiao, Ph.D.  
Patent Examiner  
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for R. Desai  
Joseph K. McKane  
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9/28/04

September 28, 2004